

REMARKS

In the office action dated September 21, 2004, Examiner has asserted that the title of the invention is not descriptive and that a new title is required that is clearly indicative of the invention to which the claims are directed.

The title has been amended to read “A Method for Retrieving Content From a Content Repository.”

Claim Rejections – 35 U.S.C. §112

Claims 1, 5, 9, 13, and 14 stand rejected under 35 U.S.C. §112 for lack of sufficient antecedent basis.

Claims 1, 5, 9, 13, and 14 have been amended in order to provide sufficient antecedent basis for the limitations in these claims. Applicant respectfully submits that Claims 1, 5, 9, 13, and 14 are currently in condition for allowance.

Reconsideration and withdrawal of the rejection is respectfully requested.

Claim Rejections – 35 U.S.C. §102

Claims 1-4 and 13-17 stand rejected under 35 U.S.C. §102(e) as being anticipated by Bengtson (US 2002/0049781).

Directing Examiner's attention to MPEP 2131, the threshold issue under Section 102 is whether the Examiner has established a *prima facie* case for anticipation. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)”. “The identical invention must be shown in as complete detail as is contained in the ...claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1566 (Fed. Cir. 1989).

Amended Claim 1 recites a software program providing instructions to perform the steps of “receiving a content retrieval request comprising a digital data representation of at least one physical feature of a requested content, wherein said digital data representation of at least one physical feature of said requested content has

been captured from said published content with a data capture device and said at least one physical feature of said requested content is mapped to said digital representation of said published content in said content repository”

Bengtson does not teach receiving a content retrieval request wherein a digital data representation of at least one physical feature of a requested content has been captured from a published content with a data capture device, as recited in Claim 1. Applicant cannot find, nor does Examiner cite, any disclosure of this limitation in Bengtson. In fact, on Page 6 of the Office Action dated September 21, 2004, Examiner even admits that “Bengtson does not explicitly teach capturing at least one physical feature of a requested content with a data capture device”

Applicant has amended Claim 1 to include the limitations from Claim 5 that Examiner admits are not taught by Bengtson. Applicant respectfully submits that Bengtson fails to teach each and every element of Claim 1, and that the amendments to Claim 1 are sufficient to overcome the §102 rejection.

The §103 rejection with respect to Claim 5 will be discussed below. All arguments made with respect to the patentability of Claim 5 are applicable to any potential §103 rejection of Claim 1 as well.

Therefore, Applicant respectfully submits that Claim 1 is currently in condition for allowance. Reconsideration and withdrawal of this rejection is respectfully requested.

Since Claims 2-4 depend from Claim 1, Applicant respectfully submits that Claims 2-4 are also patentable as they contain the same limitations as their parent claim.

Reconsideration and withdrawal of this rejection is respectfully requested.

Since Claims 13-14 depend from Claim 1, the patentability of which is discussed below, Applicant respectfully submits that Claims 13-14 are also patentable as they contain the same limitations as their parent claim.

Reconsideration and withdrawal of this rejection is respectfully requested.

Since Claims 15-17 depend from Claim 5, the patentability of which is discussed below, Applicant respectfully submits that Claims 15-17 are also patentable as they contain the same limitations as their parent claim.

Reconsideration and withdrawal of this rejection is respectfully requested.

Claim Rejections – 35 U.S.C. §103

Claims 5-12 stand rejected under 35 U.S.C. §103(a) as being patentable over Bengtson, in view of Rabin (US 6,603,464). Applicant respectfully disagrees with Examiner's contentions.

For a §103 obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. MPEP 2143.

Amended Claim 5 recites a method of retrieving content from a content repository comprising “capturing at least one physical feature of said published content with a data capture device, wherein said at least one physical feature of said published content is mapped to said digital representation of said published content in said content repository; uploading a digital representation of the at least one physical feature of the published content to a personal computing device”

Bengtson does not teach capturing at least one physical feature of a published content with a data capture device and uploading a digital representation of the at least one physical feature to a personal computing device as recited in Claim 5. Applicant cannot find, nor does Examiner cite, any disclosure of this limitation in Bengtson. In fact, on Page 6 of the Office Action dated September 21, 2004, Examiner even admits that “Bengtson does not explicitly teach capturing at least one physical feature of a requested content with a data capture device; and uploading a digital representation of the at least one physical feature of the requested content to a personal computing device.”

Examiner asserts that Rabin teaches capturing at least one physical feature of a requested content with a data capture device and uploading a digital representation of the at least one physical feature of the requested content to a personal computing device.

However, Rabin fails to disclose capturing at least one physical feature of a published content with a data capture device, wherein the physical feature of the published content is mapped to a digital representation of the published content in a content repository, as recited in Claim 5. Instead, Rabin only teaches capturing “inputs resulting from a user working with the pen and form.” Therefore, the physical features captured by the device in Rabin are created by the pen and are not related to any published content in a content repository. Since the user is creating the physical features as they are being captured, they clearly do not constitute published content in a content repository.

Although the device in Rabin also uses some of the printed indicia on the form, this data is only used “to determine where on the form the user is writing, in terms of field and position.” (Col. 4, lines 10-12). There is no mention of this data being published content that is stored on a content repository in a layout-preserving format, as recited in Claim 5.

Since Rabin fails to teach the capturing of at least one physical feature of a published content with a data capture device as recited in Claim 5, it does not teach the uploading of a digital representation of the at least one physical feature of the published content to a personal computing device. As mentioned above, the only data being captured is the user’s pen writing and the printed indicia on the form used to determine the field and position of the writing, neither of which constitutes published content that is stored on a content repository in a layout-preserving format as recited in Claim 5.

Since neither Bengtson nor Rabin teach the capturing of at least one physical feature of a published content with a data capture device or its uploading to a personal computing device in as complete detail as recited in Claim 5, their combination cannot teach these claim limitations.

Furthermore, even if Rabin did teach these claim limitations, there is no suggestion or incentive that would motivate one skilled in the art to combine the teachings of Bengtson and Rabin in order to arrive at the present invention. Although Examiner asserts that it would have been obvious to one of ordinary skill in the Data Processing art to combine the teachings of Bengtson and Rabin because it would have an efficient communications system that can collect, capture, store and distribute written and optical information over the network, there is no mention in Bengtson of a need or even a desire for such a modification. Bengtson is only directed to a simple text search wherein “a

user does a search, the full-text database is queried to obtain all publication ‘hits’.” (Page 2, 1st Paragraph). There is no need for capturing a physical feature of a published content with a data capture device, since all that is required for Bengtson is text, which can simply be entered in by the user without the complication of using a data capture device.

Applicant respectfully submits that Bengtson and Rabin fail to teach each and every element of Claim 5 either individually or in combination. Therefore, Applicant respectfully submits that Claim 5 is patentable over Bengtson, in view of Rabin and is currently in condition for allowance.

Reconsideration and withdrawal of this rejection is respectfully requested.

Since Claims 6-12 depend from Claim 5, Applicant respectfully submits that Claims 6-12 are also patentable as they contain the same limitations as their parent claim.

Reconsideration and withdrawal of this rejection is respectfully requested.


Newly Presented Claims

Applicant respectfully submits that newly presented claims 18-20 find support in the original disclosure and do not constitute new matter. Furthermore, since Claims 18-20 depend from Claim 5, Applicant respectfully submits that they are also patentable as they contain the same limitations as their parent claim. Applicant respectfully submits that Claims 18-20 are currently in condition for allowance.

If the Examiner has any questions regarding this application or this response, the Examiner is requested to telephone the undersigned at 775-586-9500.

Respectfully submitted,
SIERRA PATENT GROUP, LTD.

Dated: February 22, 2005



William P. Wilbar
Reg. No.: 43,265

Sierra Patent Group, Ltd.
P.O. Box 6149
Stateline, NV 89449
(775) 586-9500
(775) 586-9550 Fax